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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,843	06/30/2000	Kia Silverbrook	NPA063US	2333
24011	7590	04/20/2006	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, NSW 2041 AUSTRALIA			SUBRAMANIAN, NARAYANSWAMY	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/607,843

Applicant(s)

SILVERBROOK ET AL.

Examiner

Narayanswamy Subramanian

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-3,8-21,23-31,36-44 and 46-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,8-21,23-31,36-44 and 46-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to applicants' communication filed on January 27, 2006. Amendments to claims 1, 29 and 44 and cancellation of claims 22 and 45 have been entered. Claims 1-3, 8-21, 23-31, 36-44 and 46-48 are pending in the application and have been examined. The rejections and response to arguments are stated below.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 23 is dependent on cancelled claim 22 and claim 24 is dependent on cancelled claim 5. Appropriate correction/clarification is required.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 8-21, 23-31, 36-44 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman et al (US Patent 6,330,976 B1) in view of Richards et al (US Patent 6,539,361 B1).

Claim 1, Dymetman discloses a method of enabling online banking via a printed form, the form including information relating to a transaction and including coded data, the coded data being indicative of an identity of the form and at least one reference point of the form, the method including the steps of: receiving, in a computer system and from a sensing device operated by a user, indicating data from a sensing device regarding the identity of the form (See Dymetman Column 3 line 45 – Column 4 line 24) and a position of the sensing device relative to the form (See Dymetman Column 3 lines 57-67), the sensing device, when placed in an operative position relative to the form, sensing at least some of the coded data and generating the indicating data using the at least some of the coded data (See Dymetman Column 3 lines 45-67); and identifying, in the computer system and from the indicating data, at least one parameter relating to the transaction (See Dymetman Column 3 lines 45-67, the identified action is the one parameter relating to the transaction). The limitation “the information having being printed at the same time as the coded data on a surface-defining means” is not given patentable weight because it appears in the preamble. Further this limitation has no bearing on the steps of the claim because the steps of the claim are not affected by how the printing is done.

Dymetman does not explicitly teach the step where the financial transaction is an online banking transaction.

Richards discloses the step wherein the financial transaction is an online banking transaction (See Richards Abstract, Column 1 lines 16-44, Column 2 line 67 - Column 3 line 54).

Both Dymetman and Richards are concerned with providing means for conducting transactions. It would have been obvious to one with ordinary skill in the art at the time of invention to include the disclosures of Richards to the invention of Dymetman. The combination

of the disclosures taken as a whole suggests that online banking customers would have benefited from being able to use a form that makes banking easier.

Claim 29, Dymetman discloses an apparatus for enabling online banking, the apparatus including: a form containing information relating to a transaction and coded data, the coded data being indicative of an identity of the form (See Dymetman Column 3 line 45 – Column 4 line 24) and of at least one reference point of the form (See Dymetman Column 3 lines 57-67); and a computer system for receiving indicating data from a sensing device for identifying at least one parameter relating to the transaction, the indicating data being indicative of the identity of the form and a position of the sensing device relative to the form (See Dymetman Column 3 lines 45-67), the sensing device when placed in an operative position relative to the form, sensing at least some of the coded data and generating sensing the indicating data using the at least some of the coded data (See Dymetman Column 3 lines 45-67, the identified action is the one parameter relating to the transaction).

Dymetman does not explicitly teach the step where the financial transaction is an online banking transaction and the information having being printed at the same time as the coded data on a surface-defining means. The limitation “the information having being printed at the same time as the coded data on a surface-defining means” does not in any way affect the structure of the printed form or the structure of the apparatus and as such is treated as non-functional descriptive material. A printed form containing information relating to a banking transaction and coded data is not affected by how or when the information and coded data are printed. Hence this limitation is treated as non-functional descriptive material.

Richards discloses the step wherein the financial transaction is an online banking transaction (See Richards Abstract, Column 1 lines 16-44, Column 2 line 67 - Column 3 line 54).

Both Dymetman and Richards are concerned with providing means for conducting transactions. It would have been obvious to one with ordinary skill in the art at the time of invention to include the disclosures of Richards to the invention of Dymetman. The combination of the disclosures taken as a whole suggests that online banking customers would have benefited from being able to use a form that makes banking easier.

Claims 2 and 30, Dymetman discloses the step of at least one parameter relating to the transaction is associated with at least one zone of the form and in which the method includes identifying, in the computer system and from the zone relative to which the sensing device is located, said at least one parameter (See Dymetman Column 3 lines 45-67, the identified action is the one parameter relating to the transaction).

Claims 3 and 31, Dymetman discloses the steps of receiving, in the computer system, data regarding movement of the sensing device relative to the form, the sensing device sensing its movement relative to the form using at least some of the coded data; and identifying, in the computer system and from said movement being at least partially within said at least one zone, said at least one parameter of the transaction (See Dymetman Column 8 lines 27-33).

Claims 8 and 36, Dymetman discloses the step in which the parameter is an action parameter of the transaction, the method including effecting, in the computer system, an operation in respect of the action parameter (See Dymetman Column 4 lines 16-23).

Claims 9 and 37, Richards discloses the step where the action parameter includes a request for information relating to banking services, a request for a withdrawal of funds, a

request for a transfer of funds, a request for an account balance, a payment of a bill (See Richards Column 1 lines 26-44).

Claim 10, Richards discloses the step in which the parameter is an option parameter of the transaction, the method including identifying, in the computer system, that the user has entered a hand-drawn mark by means of the sensing device and effecting, in the computer system, an operation associated with the option parameter (See Dymetman Column 30 line 65 – Column 31 line 39).

Claims 11 and 38, Richards discloses the steps in which the option parameter is associated with one of a request for information relating to banking services, an order for checks, a request to stop checks, an application for a new account, an application for a loan, a request for an account history, a request for a withdrawal of funds, a request for a transfer of funds, a request for an account balance, a payment of a bill, a request for a list of bill payments, an account, a currency, and a payee name (See Richards Column 1 lines 26-44).

Claims 12 and 13, Dymetman discloses the steps wherein the parameter is a text parameter of the banking transaction, the method including identifying, in the computer system, that the banking customer has entered handwritten text data by means of the sensing device and effecting, in the computer system, an operation associated with the text parameter including converting, in the computer system, the handwritten text data to computer text (See Dymetman Column 30 line 65 – Column 31 line 39).

Claims 14 and 39, the step in which the text parameter is associated with at least one of a check amount, a payee name, a currency amount, a transfer amount, a payment amount, a

payment date, and a check number is old and well known. These steps allow a checking transaction to be identified.

Claims 15 and 16, Dymetman discloses the steps in which the parameter is an authorization parameter of the transaction, the method including identifying, in the computer system, that the banking customer has entered a handwritten signature by means of the sensing device and effecting, in the computer system, an operation associated with the authorization parameter including verifying, in the computer system, that the signature is that of the customer (See Dymetman Column 30 line 65 – Column 31 line 39).

Claims 17 and 40, Richards discloses the step in which the authorization parameter is associated with authorization for at least one of access to account information, withdrawal of funds, transfer of funds, payment of a bill, modification of a bill payment, deletion of a bill payment, stopping of checks, and ordering of checks (See Richards Column 1 lines 26-44 and Column 3 lines 1-54).

Claims 18, 19 and 41, Dymetman does not teach the steps wherein the parameter is a picture parameter of the banking transaction, the method including identifying, in the computer system, that the banking customer has entered a hand-drawn picture by means of the sensing device and effecting, in the computer system, an operation associated with the picture parameter including picture parameter associated with a graphic design for a customer's checks.

Official notice is taken that having a picture parameter of the banking transaction, an operation associated with the picture parameter, which in turn is associated with a design for customer's checks is old and well known in the art. These steps help in timely identification of



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the parameter and also minimize the text necessary to identify the item (A picture is sometimes worth a thousand words).

It would have been obvious to one with ordinary skill in the art at the time of invention to include these steps to the disclosure of Dymetman. The combination of the disclosures taken as a whole suggests that users would have benefited from the ease in identifying the parameter of interest.

Claim 20, Richards discloses a method of claim 1, in which the form contains information relating to at least one of information relating to banking services, a request for an account history a request for a withdrawal of funds, a request for a transfer of funds, a request for an account balance, and a payment of a bill (See Richards Column 1 lines 25-45).

Claims 24, 26, 47 and 43, Dymetman discloses the steps of retaining a retrievable record of each form generated, the form being retrievable using its identity as contained in its coded data (See Dymetman Column 8 lines 6-13 and Column 22 lines 49-61); the sensing device contains an identification means which imparts a unique identity to the sensing device and identifies it as being associated with a particular user and in which the method includes monitoring, in the computer system, said identity (See Dymetman Column 17 lines 39-51).

Claims 25 and 27, Dymetman discloses the steps of distributing a plurality of forms using a mixture of multicast and PointCast communications protocols (See Dymetman Column 19 lines 16-21) and providing all required information relating to the banking transaction in the form to eliminate the need for a separate display device (See Dymetman Column 16 lines 31-42).

Claims 42, Dymetman discloses the step in which the sensing device includes a marking nib (See Dymetman Figure 8 and Column 30 line 65 – Column 31 line 39)

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6. Claims 21, 23, 28, 44, 46 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman et al (US Patent 6,330,976 B1) in view of Richards et al (US Patent 6,539,361 B1) and further in view of Sekendur (WO 97/22959).

Claims 21, 23, 28, 44-46 and 48, Dymetman discloses a method and apparatus of claims 1 and 29 respectively as discussed above.

Dymetman does not explicitly teach the steps of printing the form on demand, thereby allowing a sensing device to sense coded data provided on the printed form, printing the coded data on the surface where the coded data to be substantially invisible in the visible spectrum and a form printed on multiple pages, the printer includes a binding means for binding the pages.

Sekendur discloses the steps of printing the form on demand, thereby allowing a sensing device to sense coded data provided on the printed form, including printing the form on a surface of a surface-defining means and printing the coded data on the surface where the coded data to be substantially invisible in the visible spectrum (See Sekendur pages 8-10). Official notice is taken that printing on multiple pages and binding the pages is old and well known in the art. Printing on multiple pages and binding them helps keep the records together.

Both Sekendur and Dymetman are concerned with the problem of making it easier for a user to input and read data for processing by a computer. It would have been obvious to one with ordinary skill in the art at the time of invention to include these steps to the disclosures of Patterson. The combination of the disclosures taken as a whole suggests that users would have benefited from the time savings over a manual process and from keeping the records together by printing on multiple pages and binding them.

***Response to Arguments***

7. Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dr. N. Subramanian *NS*  
April 13, 2006



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